

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

070325.040017

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on March 26, 2008

Signature _____

Typed or printed

name Angela Williams

Application Number

09/849,513

Filed

May 5, 2001

First Named Inventor

Dennis G. Earnshaw

Art Unit

3629

Examiner

Naresh Vig

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.



The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the



applicant/inventor.



assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)



attorney or agent of record.

Registration number 38,387



attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

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Telephone number

March 26, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.



*Total of ONE forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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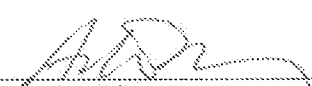
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Dennis G. Earnshaw, et al. Examiner: Naresh Vig
Application No. 09/849,513 Group Art Unit: 3629
Filed: May 5, 2001 Docket No. 070325-040017
Title: ***ELECTRONIC TRANSACTION SERVICE SYSTEM***
Customer No.: 33717

CERTIFICATE OF TRANSMISSION

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Name: Angela Williams

LETTER SUBMITTING REMARKS WITH
PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP: AF
Commissioner for Patents
Post Office Box 1450
Alexandria, Virginia 22313-1450

Dear Sir/Madam:

This paper is being filed with a Pre-Appeal Brief Request For Review and a Notice of Appeal.

Applicants seeks formal review by a panel of Examiners of the rejections of claims 1-10, 14-20 and 22-24 under 35 U.S.C. § 103(a) in the Final Office Action dated November 26, 2007. The Examiner has maintained these rejections in Advisory Actions dated January 29, 2008 and March 18, 2008. The claims have been rejected twice. Accordingly, applicants appeal of the rejections and request for pre-appeal brief review are timely and proper.

In particular, applicants request review of the rejections of claims 1-10, 14-20 and 22-24 under 35 U.S.C. § 103(a) over IBM Corporation Product Facsimile Support/400 ("IBM") in view of U.S. Patent No. 6,424,426 issued to Henry ("Henry") and U.S. Patent No. 6,775,711 issued to Akimoto ("Akimoto").

I. The Examiner's Combination of *IBM*, *Henry*, and *Akimoto* Does Not Provide a Prima Facie Case of Obviousness

Independent claim 19 recites an electronic business transaction service method for conducting a business transaction over a computer network and sending an electronic business transaction document in a preferred communication format to each recipient party. A transaction service server interprets preferred communication format indicators in electronic business transaction document to determine the communication format each recipient party should receive electronic business transaction document (e.g., computer communication format or non-computer communication format).

The Combination of IBM, Henry & Akimoto Fails to Teach or Suggest Interpreting Preferred Communication Format Indicators

It is admitted in the Office Action that “*IBM* in view of *Henry* does not explicitly teach capability for determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction.” *See first full paragraph on page 5 of the Office Action.* *Akimoto* is then cited to cure this deficiency by asserting that *Akimoto* teaches determining a preferred communication format for each of the plurality of recipient parties of a business transaction.

However, *Akimoto* fails to teach or suggest determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties. Communication formats are formats for communication to the recipient parties (e.g., computer communication format, non-computer communication format, telephonic facsimile, regular mail, etc.). To the contrary, *Akimoto* is directed to an email communication system having a single communication format – namely, all communications occur according to a standard MIME email format. *See col. 5, lines 19-34 & col. 9, lines 44-47 of Akimoto.* There is no teaching or suggestion in *Akimoto* that transmissions to recipients can occur in any format other than standard email transfer protocol format (i.e., MIME).

The Office Action cites *Akimoto*'s Figure 8 and the associated description as teaching preferred communication formats of recipient parties. *See Page 5, Final Office Action dated November 26, 2007.* Rather than describing preferred communication formats for sending documents to recipient parties, Figure 8 and its related description in *Akimoto* discuss how various

identification characters can be used to signify that certain processes be performed on the email that is being sent. See *Akimoto*, col. 8, lines 30-35 (describing Figure 8). Figure 7 brings further understanding to *Akimoto*'s identification characters. The email communication system of *Akimoto* detects special characters "A" to "C" after the identification character "@" in the email address to determine that special processing associated with these characters is executed. For example, when the identification "A" is added, signature processing is carried out. When the identification "B" is added, encryption processing is carried out. See *Akimoto*, col. 7, lines 25-35.

As clearly shown at the bottom of the flow chart illustrated in Figure 8, regardless of which type of content processing has been indicated to be performed by the identification characters, all communications are ultimately transmitted in (step T15) in an email transmission protocol format where determinations are made in steps (T13) and (T14) to ensure that the recipient address is a suitable email format. See *Akimoto*, col. 8, lines 60-65. Instead of disclosing determining different communication formats as asserted in the Office Action, Figure 8 and its respective description in *Akimoto* discuss how various identification characters are used to process the content of an email (e.g., signature or encryption processing) before the content is transmitted according to an email transfer protocol format. As such, *Akimoto* only discloses that a computer communication format (i.e., email transfer protocol) is used for all communications to recipient parties.

It is respectfully submitted that the communication format remains unchanged in *Akimoto* (e.g., the communication format is always e-mail transfer protocol). As such, *Akimoto* fails to cure the deficiency of *IBM* and *Henry* admitted by the Examiner as failing to teach capability for determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction.

Contrary to the teachings of the cited prior art, independent claim 19 recites that transaction service server computer determines a preferred communication format for each of the plurality of recipient parties of the business transaction by interpreting communication format indicators in the electronic business transaction document itself.

Independent Claim 19 Further Recites Automatically Retrieving a Preferred Communication Format Indicator from an Electronic Address Book

IBM is cited in the Office Action as disclosing an address book for retrieving a preferred communication format indicator for each of the plurality of recipient parties of the business

transaction, as recited in independent claim 19. Applicants respectfully traverse this characterization of *IBM* and submit that *IBM* actually teaches away from this feature.

IBM teaches that all communications must occur according to the industry standard CCITT Group 3 fax format, where *IBM* expressly indicates that it is an important characteristic of its Facsimile Support/400 outbound process that all pages are converted to the CCITT Group 3 fax format. *See pages 4-5 of IBM*. As such, since all communications sent to recipient parties by the *IBM* device occur according to the industry standard CCITT Group 3 fax format, it would be contradictory to the teachings of *IBM* to store different communication format indicators in the *IBM* address book.

Applicants respectfully submit that *IBM* does not disclose the limitations that the Examiner has indicated to be taught in *IBM*. Namely, there is no disclosure in *IBM* of completing an electronic business transaction documents by retrieving preferred communication formats from an electronic address book on the client computer, as recited in independent claim 19. This feature is further not taught by the other cited prior art references. *Henry* discloses a system where users manually fill out a form with email addresses and scan such form into a fax machine so that it is faxed to a fax server. Still further, *Akimoto* discloses an email communication system where all communications are sent according to an email transfer protocol format and there is again no teaching or suggestion of retrieving preferred communication formats from an electronic address book on a client computer in any of the cited *IBM*, *Henry* and *Akimoto* prior art references.

Independent Claims 1, 14 and 19 Further Transmission of an Electronic Business Document Between a Computer and Server Over a Computer Network

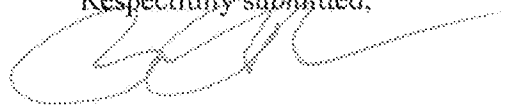
Independent claims 1, 14 and 19 of the present application recite that the electronic business transaction document is created on a client computer and is received by the transaction service server computer communicating with the client computer through a computer network. *Henry* is cited in the Office Action as teaching a business server capable of sending business documents in different formats. However, *Henry* does not teach a business management software program as disclosed in the present application nor does *Henry* disclose a server receiving an electronic business document over a computer network. Rather, *Henry* discloses technology related to the Internet fax service MongoNet (e.g., see www.mongonet.com) where users manually fill out a form with email addresses and scan such form into a fax machine so that it is faxed to a fax server. The document in *Henry* is

created by a user that fills in the email address on the form, not by a computer program. The document in *Henry* is sent via facsimile to the fax server, not over a computer network in electronic form to the server. Thus, it is respectfully submitted that *Henry* fails to teach a transaction server computer that receives an electronic business transaction document created on a client computer that is received through a computer network, as recited in independent claims 1, 14 and 19.

CONCLUSION

Accordingly, in light of the foregoing remarks it is submitted that there is no factual or legal basis shown for the Examiner's rejections under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been made. Reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejections of the independent claims discussed above and their respective dependent claims which depend there from is respectfully requested. The Commissioner is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to **Deposit Account Number 50-2638**. Please also credit any overpayments to said Deposit Account. Please ensure that Attorney Docket Number 070325-040017 is referred to when charging any payments or credits for this case.

Respectfully submitted,



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Date: March 26, 2008

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